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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,194	06/22/2001	Anthony J. Kinney	BB1449 US NA	9205

23906 7590 05/10/2006

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EXAMINER

ASHEN, JON BENJAMIN

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 05/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/887,194

Applicant(s)

KINNEY ET AL.

Examiner

Jon B. Ashen

Art Unit

1635

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 April 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 02 May 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): 112 2nd paragraph of claims 53-59.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 53-59.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

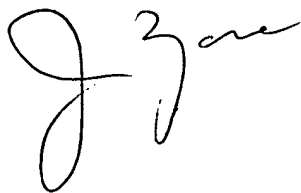
11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

JANE ZARA, PH.D.
PRIMARY EXAMINER

Joe Z
+C1600

Continuation of 11. does NOT place the application in condition for allowance because: Claims 53-54, 57 and 58 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement for the reasons of record as set forth in the Action mailed 12/29/2005, because claims 53-54, 57 and 58 contain new matter. In response to Applicant's arguments filed 4/27/2006 (pg. 9), it is noted that Applicant's response of 10/21/2006, as pointed to by Applicant, also indicated that support for the amendments of claims 53-54, 57 and 58 recite specific portions of SEQ ID NO: 13 could be found in the specification at pg. 37, lines 1-22, as is now indicated on pg. 9 of the instant remarks. However, pg. 37, lines 1-22, while disclosing SEQ ID NO: 13, is silent with regards to any particular nucleotides of SEQ ID NO: that are required or not required and indicates, in the subsequent paragraph, that vector (i.e., the instant construct) can be variable in size (40 - 300 bp) and that the construct can be effective over a variable range of sizes and sequences (see pg. 37, lines 25-30, for example). Therefore, the specification as filed provides no support for the newly added claim limitations of particular regions of SEQ ID NO: 13. If Applicant believes that the particular support for the newly added limitations of particular regions of SEQ ID NO: 13 is found in the specification as indicated, Applicant should point out, with particularity, how the instant disclosure provides support for what is now claimed. Claims 53-59 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement for the reasons of record as set forth in the Action mailed 12/29/2005. Claims 53-59 continue to read broadly on compositions and methods comprising a vast genera of recombinant constructs and the RNA's that are expressed from such constructs. Applicant's arguments have been fully considered but are not persuasive. Applicant's has pointed to disclosures of the specification which assert that the nucleotide construct of the invention and its target mRNA should be at least 80% identical (see pgs 8-9). Applicant has also argued that the exemplification of the invention via the suppression of 4 (and has emphasized 4) different target mRNAs expressed in soybean together with the declaration by Dr. Johan Stoop, indicates to one of ordinary skill in the art that Applicant was in possession of "the constructs and RNAs that will function to reduce the expression of any target mRNA or any endogenous RNA expressed in soybean that has at least 80% sequence identity with a sequence homologous to all or part of the RNA having homology to at least one target mRNA expressed in soybean" (pg. 9). However, contrary Applicant's argument, the assertion of the specification, the few examples provided by Applicant and the declaration provided by Dr. Johan Stoop do not provide the required adequate written description of the invention as set forth for the reasons of record (see pgs. 12-14, response to arguments and Declaration, mailed 12/29/2005). Applicant has provided no substantively new argument and Applicant's amendments to the claims have not reduced the breadth of what is now claimed such that the skilled artisan would recognize that Applicant was in possession of a representative number of functional species of the broad genera of claimed constructs and RNAs. Applicant's arguments that the constructs of the invention are defined by structural terms and functional terms have been fully considered but are not persuasive (pg. 9) because the basis of the rejection considers that it is the correlation between the structure as claimed and the breadth of the function as claimed, that is lacking in Applicant's disclosure of the instant invention. Claims 53-59 are rejected under 35 U.S.C. 112, first paragraph, for the reasons of record as set forth in the Action mailed 12/29/2005. Applicant's arguments have been fully considered but are not persuasive. Contrary to Applicant's assertion, no specific guidance is provided by the specification that would lead the skilled artisan to the instant invention in its full scope (as set forth in the reasons of record, see pgs 12-15, Action mailed 12/29/2005). Applicant has argued that the disclosure of the instant specification coupled with the examples and declaration provided, provide specific guidance to one of ordinary skill in the art as to which constructs are "likely to lead" to suppression of a target gene. However, contrary to this assertion, as set forth in the rejection of record, the state of the art of inhibiting gene expression using inhibitory nucleic acids is unpredictable and specific guidance, beyond what has already been considered and found to be inadequate, would be required to enable the full scope of what is being claimed in this art. .

TC 1600

JANE ZARA, Ph.D.
PRIMARY EXAMINER